



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,192	05/23/2000	Kia Silverbrook	NPA048US	9205

24011 7590 01/21/2003

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

GRANT II, JEROME

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/575,192

Applicant(s)

SILVERBROOK ET AL.

Examiner

Jerome Grant II

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-154 is/are pending in the application.
- 4a) Of the above claim(s) 29-154 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2624

### Response to the Restriction Requirement

1. In the Amendment received Dec. 6, 2002, applicant has included claims 87 and 138 which are directed to claims that were withdrawn from consideration for the reasons presented in the communication of Sept. 12, 2002. The the claims were drawn to subject matter not originally presented as apart of claims 1-28.

The examiner's restriction requirement is clear and firm. Applicant is urged to see MPEP 819.

If applicant persists in the consideration of claims 29-154 which are directed toward matter that is indepenedent and distinct from the invention of the originally presented claims, applicant should submit a petition as required by 37 C.F.R. 1.144.

Art Unit: 2624

**Restriction by Original Presentation**

Group I Claims 1-28 are directed toward a first group of claims which include printing at least one page of a printed document, Classified in class 358 subclass 401.

Group II Claims 29-86, 98-137 and 146-154 are, drawn to a method to enable a copy of only a portion of a document to be printed. This invention is classified in class 358, subclass 453.

Group III Claims 87-97 and 138-145 are directed toward scanning a physical object, such as a three dimensional object, classified in 382 subclasses 131 and 132..

2. Inventions of groups I , II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the inventions have separate utility such as Group I, scanning a regular two dimensional document; group II, scanning only preselected data from a document, requiring image recognition or image portion selection for eliminating or selecting information for printing; and group III scanning a physical object ie, a soda can, person, or surveillance application . See MPEP § 806.05(d).

Art Unit: 2624

3. Newly submitted claims 29-145 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

4. Claims 1-28 are directed toward a method of printing at least one page of a printed document.

Claims 29-86, 98-137 and 146-154 are directed toward a method to enable a copy of only a portion of a document to be printed. This means that the entire document is not to be reproduced as is suggested in the first group, claims 1-28.

Claims 87-97 and 138-145 are directed toward making a copy of a physical object which is distinct from the other two groups. Within the third group, three dimensional objects may be scanned, whereas in the first and second groups, these claims were restricted to scanning a two dimensional document.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-145 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Art Unit: 2624

5. **This Restriction Requirement to claims directed to the invention as Described in claims 1-28 is MADE FINAL.**

**Detailed Action**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12, 14-17, 19, 20 and 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemelson.

With respect to claims 1 and 14 Lemelson teaches a method of providing a copy of at least one page of a printed document, the document including coded data (25) indicative of the identity of the document (21) and of at least one reference point of the document (right margin), the method including the steps of: receiving, in a computer system, (39N or 30) indicating data from a sensing device 39A, 39C - by a user ( col. 5, lines 60-65) indicating the position of the

Art Unit: 2624

sensing device relative to the document ; identifying the computer system (col. 5, lines 50-60) and a request for a copy of a page of a document (col. 6, lines 5-10); and transmitting, from the system relevant document data to at least a printer for effecting a print (col. 9, lines 42-51).

With respect to claims 2 and 15, Lemelson teaches a zone of a document (right margin) having information associated with the copy of a page and used to identify the zone where a sensing device is located. See figures 3 and 5.

With respect to claim 3, Lemelson teaches the receiving step as claimed in accordance with step 74 and 77 of figure 10. See also col. 4, lines 10-17. Lemelson teaches identification a request for copy in the zone. See sensing of magnetic information on sheet. See col. 4, lines 22-27 and 37-42.

With respect to claim 4, Lemelson shows method using a printed document 21 with line coded data 25 indicative of a request including the steps of:

receiving, a sensing device (39a, 39C) operated by a user ( col. 5, lines 60-65) so that the document is positioned relative to the sensors (col. 4, lines 5-27); and transmitting relevant document data to effect printing, see col. 9, lines 42-51.

With respect to claim 5, Lemelson shows providing a copy of a page 21 with coded data 25 including the steps of receiving in a computer system a sensing device (39a, 39c) operated by a user (coll 5, lines 60-65) so that the documents move relative to the sensing device ( col. 4, lines 5-27); interpreting a movement of a sensing device as designating the request (via

Art Unit: 2624

microprocessor 30 or computer 39N); and transmitting relevant document data to at least one printer (see col. 9, lines 42-51).

With respect to claim 6, Lemelson teaches a method of copying at least one document 21 including coded data 25, the method including: receiving in a computer system (39N or 30) data from a sensing device 39A, 39C regarding ID of a user (user of printer having predetermined ID according to col. 4, lines 45-52), this information containing the ID of the user and the sensor of the computing device which identifies a document having the coded data 25; identifying document (Col 5, lines 50-60 and col. 6, lines 5-10) and transmitting relevant document data to a printer (see col. 9, lines 42-51). Print request data is addressed at col. 6, lines 6-14, see also col. 9, lines 40-50.

With respect to claim 7, the coded data appears in the margin of document 21 as data 25. Sensing device 39A and 39C reads the coded data.

With respect to claim 8, see col. 4, lines 5-27.

With respect to claim 9, see col. 9, lines 42-51.

With respect to claim 10, data exists on the magnetic strip. The data on the strip is invisible since it is digitally represented.

With respect to claim 11, the identification means is the microprocessor in accordance with col. 7, lines 9-15) which gives a unique identity of a user see also col. 4, lines 45-52.

With respect to claim 12, see col. 9, lines 40-50.



Art Unit: 2624

With respect to claim 16, see step 74 and 77 and fig. 10 of Lemelson. See also col. 4, lines 9-27.

With respect to claim 17, Lemelson teaches a computer system 39N or 30 for receiving data from sensors 39A or 39C by a user (col. 5, lines 50-60); the sensor sensing coded data 25 and the system making printed copies (see col. 9, lines 42-51)

With respect to claim 19, Lemelson teaches a system for printing documents 21 including coded data 25, the system including: a computer system 39N or 30 for sensing data (39A or 39C) regarding the identity of a user (see col. 5, lines 50-60) as the document is moved relative to the sensor. Lemelson teaches sensing data in the magnetic strip portion of 25; the computer system being configured to transmit relevant document using the coded data document data being sent to a printer as discussed at col. 4, lines 22-27 and 37-42.

With respect to claim 20, see col. 4, lines 20-27.

With respect to claim 21, see the sensing devices 39A and 39C.

With respect to claim 22, Lemelson teaches the sensing device 39A and 39C recognizes marks on a magnetic nib.

With respect to claim 23, Lemelson teaches unique identity information for a user according to col. 3, line 60- col. 4, line 5. See also col. 4, lines 45-52.

With respect to claims 24-26 ,see col. 2, lines 10-15; col. 5, lines 52-55 and col. 9, lines 41-48.

Art Unit: 2624

With respect to claim 27, see the digital data recorded on the magnetic strip.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 18, 21, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson in view of the Well Known Prior Art 2144.03.

Regarding claims 13 and 28, Lemelson teaches all of the limitations upon which the claim depends except for binding the pages.

However, this limitation is obvious in view of printers which are well known to have a staple means. In other words, the printer makes the prints of a plurality of sheets and binds them by means of a stapler. This is a common feature with printer and copiers and would have been recognized by one of ordinary skill in the art.

Art Unit: 2624

Regarding claim 18 and 21, Lemelson teaches all of the subject matter upon which the claim depends except for moving the sensing device relative to the document. See also col. 4, lines 22-27 and 37-42.

Lemelson shows moving the document relative to the sensing means. Moving the sensing means relative to a document is well known in the art. Such is the case with bar code type readers, for example.

It would have been obvious to one of ordinary skill in the art to replace or modify the scanner of Lemelson so that the sensor is moved relative to the document such as performed by references well known in the art, i.e., bar codes and other optical readers.

#### **Examiner's Remarks**

Applicant's remarks have been considered but are unpersuasive to allow the claims. AT page 2 of applicant's remarks, applicant argues "There appears to be no disclosure or discussion of printing out a copy of the card." Upon close review of claim 1, there is no recitation in the claim that is either suggested or specifically sets forth regarding "printing on a card". Applicant suggests that Lemelson does not print a document which has coded data. The examiner submits that a user provides a copy of a printed document (in this case) it is card 21. This limitation

Art Unit: 2624

reflects the language in the preamble of claim 1. This card is described at col. 3, line 60 to col. 4, line 5. The information on the document 21 includes coded data exemplified in the form of magnetic information, see col. 3, lines 66-69. Furthermore, the contents of the card may be physically printed as described at col. 5, lines 55-60.

At page 7 of the remarks, applicant states that the magnetic strip 25 of Lemelson is not indicative of the position of the sensing device with respect to the data. Nowhere in Lemelson is there disclosed a mechanism whereby the sensing device provides data that indicates the position of the sensing device relative to the document. In response to this argument, it is not clear what claim is specifically being argued in view of Lemelson. There are eight independent claims. Which claim is applicant arguing ?

At the top of page 8, applicant argues "the data encoded by the magnetic strip 25 includes only the information required to run the program associated with the card, not any indication of that data's position or a reference point on the card." Again, it is not clear what claims are being argued and would otherwise include the limitation argued above. Assuming that anyone of the eight claims suggests such language, the position of document data is located in the rightmost margin of document 21, as shown by figure 3. The strip does serve as a reference point for which data is extracted therefrom so that different processes can be executed on the document.

Art Unit: 2624

In the second paragraph, at page 8, Applicant argues that Lemelson cannot use the document identity and the position of the sensing device in relation to the document in order to generated a copy request for some or all of the documents. Upon closer view, it has not been determined which claims contain this limitation. None of the claims apparently do. It appears that applicant is arguing limitations which are not supported in the claim.

In response to the applicant's contention found on page 8 of applicant's remarks, in the second full paragraph, Lemelson teaches a magnetic strip that contains coded data. This coded data is then decoded by processor 30. Applicant appears to argue limitations which are not supported in the claim. Furthermore, it is not clear which claim is being argued. Upon closer view of the second full paragraph, there is no limitation in the independent claims which suggests a coded data identifies the location of the sensing device, yet this is the argument that applicant makes in the second full paragraph.

With respect to applicant's argument found at the bottom of page 8, applicant argues that Lemelson does not teach "having information associated with the copy of a page and used to identify the zone where a sensing device is located." Upon closer view of claim 2, applicant is arguing an issue that is unrelated to the claim. For example, claim 2 recites that a request is associated with a zone of the document. Col. 9, lines 45-50 states that a request for a print out of answers are affected by the computer in accordance with signals generated from the printed codes of the last card. The printed codes are stored in the right margin of the of card 21. Hence

Art Unit: 2624

Lemelson has addressed this limitation of the claim. Moreover, claim 2 recites that a method identifies, from the zone relative to which the sensing device is located, a request. Thus, Lemelson teaches a method which is performed by the combination of apparatus provided by figures 3 and 5 respectively. The zone relative to the sensing device corresponds to magnetic strip 25. The sensing device is the magnetic head 28. Thus the request is when the operator desires to interact with the system requesting a printing result or an interactive result.

With respect to applicant's argument directed to claim 4, applicant should specifically recite the movement that would define over that as taught by Lemelson. The examiner has clearly explained the "movement" as recited in the office action to this claim.

Art Unit: 2624

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is (703) 305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore, can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

J. Grant II

Jan. 14, 2003



JEROME GRANT II  
PRIMARY EXAMINER